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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,235	03/08/2000	KISHORE S SWAMINATHAN	AND1P535	1907

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ACCENTURE CHICAGO 28164  
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/521,235

Applicant(s)

SWAMINATHAN ET AL. 

Examiner

Maikhanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is responsive to communications: RCE filed 06/10/2004 to the original application filed 03/08/2000.
2. Claims 1-24 are currently pending in this application. Claims 1, 7 and 13 are independent claims.

***Request Continuation for Examination***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/10/2004 has been entered.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-6 and 13-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to independent claims 1 and 13, the claims read on a mental process or the manipulation of an abstract idea. The claim limitations are not explicitly directed toward steps being implemented on a computer, computer readable medium, or other statutory

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device. As such, they could be carried out mentally. For example, a person could develop a dossier including a "name of a client" in his/her mind, and develop the dossier mentally. In the preamble, "developing a dossier" does not make the claim statutory because a mental process can also "developing a dossier".

**Dependent claims 2-6 and 14-24** also read on mental process, and are rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9-13, 15-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitain et al.** (U.S. 5,864,871 – filed 01/1997).

**As to independent claim 1**, Kitain teaches a method for developing a dossier, comprising the steps of:

- receiving a name of a client (*the user is required to provide ...the repository server will determine what information that user is authorized to receive; col.5, lines 63-67 / the web server can provide customized views ... to users; col.6, lines 43-61*);

- allowing selection of an industry from the list of industries (it lists the industries that the user may choose as selection criteria for documents; col.39, lines 1-67 & Fig.3);

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- searching for information relating to the client and the selected industry (*a list of the documents that fits certain user-specified search criteria ... match that search criteria; col.10, lines 46-54 & Figs.3-4*); and

- preparing the dossier utilizing the information found during the searching (*a list of the headlines of reports and items of corporate information ...reports that satisfy a user's query; col.46, lines 48-67 / query results listing research reports ...satisfying the query; col.47, lines 16-52 & Fig.7*).

While teaching presenting a list consisting of industries (*a list of companies and place the list in a form from which the user can choose a company; col.21, lines 36-38 / lists the industries that the user may choose ...industry groups 210; col.39, line40 – col.40, line 19 & Fig.3*), Kitain, does not explicitly teach “industries associated with the client”.

Kitain, however, discloses *Advertising, Aerospace, Agriculture, Air Transportation, Apparel & Textiles* are associated with industries (*Fig.3*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply Kitain's teaching for “industries associated with the client” in order to allow remote users to access and query information that is stored in electronic form at a central server.

**As to dependent claim 3**, Kitain teaches the steps of displaying topics associated with the client and allowing selection of at least one of the topics for insertion of information relating to the selected at least one of the topics in the dossier (*the page 100, displayed ...a list of reports and items of incorporated information ...the user can select a headline; col.47, lines 11-29 & Fig.7*).

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**As to dependent claim 4**, Kitain teaches the dossier is arranged in sections according to people, documents, and projects (*Each report and item of corporate information is listed on a single line, with information about it; col.47, lines 11-29 & Fig.7*).

**As to dependent claim 5**, Kitain teaches the people section is arranged according to the number of documents and projects an individual has produced related to the client or industry (*Fig.7, items 704, 712 and col.7, lines 16-29*).

**As to dependent claim 6**, Kitain teaches the documents and projects sections are arranged chronologically (*Each report and item of corporate information is listed on a single line, with information about it including the time of submission of the report; col.7, lines 16-29 & item 702 in Fig.7*).

**As to independent claim 7**, it is directed to a computer program for implementing the method of claim 1, and is similarly rejected under the same rationale.

**As to dependent claims 9-12**, they include the same limitations as in claims 3-6, and are similarly rejected under the same rationale.

**As to independent claim 13**, it is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

**As to dependent claims 15-18**, they include the same limitations as in claims 3-6, and are similarly rejected under the same rationale.

**As to dependent claim 19**, Kitain teaches searching for information relating to the at least one of the selected topics, and displaying the information related to the at least one of the selected topics (*col.45, lines 1-46*).

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**As to dependent claim 21**, Kitain teaches the list of associated industries is presented in response to receiving the name of the client (*col. 21, lines 36-38*).

**As to dependent claim 22**, Kitain teaches storing the association of one or more industries with the name of the client (*Fig. 3 and associated text*).

**As to dependent claims 23- 24**, they include the same limitations as in claim 22-23, and are similarly rejected under the same rationale.

7. Claims 2, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitain et al.** in view of **Danish et al.** (U.S. 6,327,588 – filed 10/2000 which is continuation of application # 09/384,303 – filed 08/1999).

**As to dependent claims 2, 8 & 14**, Kitain does not explicitly teach “presenting an alternate list consisting of industries not associated with the client.”

Danish teaches presenting an alternate list consisting of industries not associated with the client (*a list box 15 comprising alphabetical listbox entries; col. 5, line 62-col. 6, line 10*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature from Danish in the system of Kitain because it would have provided the capability for identifying an item among a family of items based on selections of alternatives among features associated with the items.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kitain et al.** in view of **Wical** (U.S. 6,240,410 – filed 05/1999).

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As to dependent claim 20, Kitain does not explicitly teach “arranged sections include displayed expanded node and subnodes.”

Wical teaches arranged sections include displayed expanded node and subnotes (*Abstract*).

It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine Wical’s teachings in the system of Kitain as modified by Bezos because it would have provided the capability for ordering documents in a hierarchical structure that includes a plurality of hierarchical level based on pre-defined categories.

### ***Response to Arguments***

9. Applicants’ arguments filed 06/10/2004 have been fully considered but they are not persuasive.

Applicant argues that *Kitain is silent as to whether or not the industries may be associated with a specific company*. (Remarks, page 7, second paragraph)

In response, although Kitain does not explicitly teach the industries may be associated with a specific company, Kitain does suggest that *Advertising, Aerospace, Agriculture, Air Transportation, Apparel & Textiles* would be considered as clients.

As to dependent claims 2-6, 8-12, and 14-24, the arguments are not persuasive for reason as discussed above with regards to independent claims 1, 7, and 13.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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De I'Etraz et al.      U.S Patent No. 6,324,541      issued: Nov. 27, 2001

Goiffon                  U.S Patent No. 6,327,593      issued: Dec. 4, 2001

Mielenhausen          U.S Patent No. 6,529,911      issued: Mar. 4, 2003


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
July 8, 2004

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**